No. 444.

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OCTOBER TERM, 1898.

THE UNITED STATES *ex rel.* ALFRED L. BERNARDIN, *Plaintiff in Error*,

vs.

CHARLES H. DUELL, Commissioner of Patents, *Defendant in Error*.

No. 444.

Additional Points for Plaintiff in Error on Oral Argument.

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Additional Points for Plaintiff in Error on Oral Argument.

I.

Can the plaintiff in error, having had and not availed himself of the opportunity, by motion to dismiss, upon the appeal by Northall from the Commissioner's decision, to question the constitutionality of that "appeal," question it now in a mandamus proceeding in the Supreme Court of the District?

This point was not raised by either the court or opposing counsel at any of the hearings before the Supreme Court of the District or the Court of Appeals; and this is the reason it has not heretofore been considered.

The failure to raise the question of the constitutionality of this "appeal" at the time the "appeal" was taken and the submission by the plaintiff in error to the jurisdiction of the

Court of Appeals upon that "appeal," did not, of course, *confer* jurisdiction upon the Court of Appeals; for, if a court has no jurisdiction over the *subject matter*, the *appearance* of the *parties* can not confer it.

Moreover, such failure and submission would not have been considered a *waiver* of the right to raise that question *at any stage* of the proceedings, had it been possible to carry that "appeal," and had in fact that "appeal" been carried to a higher Court (the Supreme Court). (See Parker *vs.* Ramsby, 141 U. S., 81 and Mex. R. R. Co. *vs.* Davidson, 157 U. S., 201.)

Nor were such failure and submission a *waiver* of the right to raise that question *in other than the same proceedings*, or, in other words, *collaterally*. (See Rose *vs.* Himely, 4 Cr., 241; Elliot *vs.* Piersol, 1 Pet., 328; Hickey *vs.* Stewart, 3 How., 750; Christmas *vs.* Russell, 5 Wall., 290; Thompson *vs.* Whitman, 18 Wall., 457; and Bissell *vs.* Briggs, 9 Mass., 462.)

In Rose *vs.* Himely, in passing upon the jurisdiction of a foreign court, inquired into in a circuit court, Chief Justice Marshall said:

> "Upon principle, then, it would seem that, to a certain extent, the capacity of the court to act upon the thing condemned, arising from its being within, or without, their jurisdiction, as well as the constitution of the court, may be considered by that tribunal which is to decide on the effect of the sentence."

In Elliott *vs.* Piersol, the jurisdiction of a county court was inquired into in the circuit court. Trimble, J., said:

> "But if it act without authority, its judgment and orders are regarded as nullities. They are not voidable, but simply void. * * *
>
> "* * * The jurisdiction of any court exercising authority over a subject may be inquired into in every court, where the proceedings of the former are relied on and brought before the latter by the party claiming the benefit of such proceedings."

In Hickey *vs.* Stewart, the original decision had been rendered by the Supreme Court of Mississippi, and it was questioned in

the Circuit Court for the Southern District of Mississippi. The Court said:

> " * * * That Court had no jurisdiction over the subject-matter, and * * * the whole proceeding is a nullity."

In Christmas *vs.* Russell, the Circuit Court of Mississippi inquired into the jurisdiction of a State court in Kentucky.

In Thompson *vs.* Whitman, the Circuit Court in New York inquired into the jurisdiction of a New Jersey court.

In Bissell *vs.* Briggs, the Supreme Judicial Court of Massachusetts inquired into the jurisdiction of the Superior Court of Judicature of New Hampshire.

This leaves us to inquire only whether, considering the relationship which exists between the Supreme Court of the District and the Court of Appeals *as its appellate court*, this question of the jurisdiction of the Court of Appeals may be passed upon by the Supreme Court of the District under the circumstances *of the case at bar.*

We are willing to admit that, had the question of the constitutionality of this "appeal" *been raised* in the Court of Appeals upon the "appeal" from the Commissioner and *been passed* upon, its decision upon that point would have been final, so far as *the Supreme Court of the District* is concerned, so that we could not have raised the same question afterwards upon a mandamus proceeding instituted in the Supreme Court of the District. This would be so, because, if not so, the lower court, under such circumstances, would have an opportunity primarily to overrule its superior court, while, at the same time, the decision of the lower court would be subject on appeal to the review of the upper court; and the presumption of the law being that a court will reaffirm its own previous holdings, this would be *useless litigation.*

The Court of Appeals did not, however, pass upon its jurisdiction on the appeal from the Commissioner; so that, when the petition for mandamus was filed, *there was no decision of the Court of Appeals upon that question.* The only points passed

upon by that Court were those contained in the record transmitted from the Patent Office.

Under such circumstances, even had the Supreme Court of the District (as it did not), upon the petition for mandamus, held that the Court of Appeals had no jurisdiction over the appeal from the Commissioner, its decision would not have been an attempt to overrule, and would not have even primarily overruled, any decision of the Court of Appeals, its superior court; because, first, the Court of Appeals had not passed upon the constitutionality of the "appeal," and secondly, because, *so far as this jurisdicton on "appeal" is concerned*, the Court of Appeals is not an appellate court over the Supreme Court of the District.

That our position is sound, we refer your Honors to People *vs.* Clark, 1 Park. Cr. C. (N. Y.), 360, wherein Justices Edwards, Mitchell and Roosevelt sat. It appears that the trial court found the defendant guilty; that a new trial was awarded by the Supreme Court; and that this order was vacated by the Court of Appeals. The defendant was not present in the Court of Appeals when they heard the argument; and that court did not pass upon the question whether they had jurisdiction over him under such circumstances. This question, however, was raised in the Supreme Court after the decision had been rendered by the Court of Appeals; and Mitchell, J., said:

> "The prisoner's counsel very properly refrained from addressing to the court a single argument against the decision of the higher court, on the point on which the court and this differed. If the appellate court had jurisdiction, its decision became the law of the case; * * *. But the question whether the Court of Appeals had jurisdiction, was very properly argued before us. * * * In this case, the question now presented, whether in a criminal case, where the punishment is to be corporeal, any court has jurisdiction over the prisoner unless he be brought before it, was never brought before that court, and so that court did not 'decide upon its own jurisdiction in that respect.' The question, therefore, remains open."

Along the same line, though not directly in point, is Davis *vs.* Packard, 8 Pet., 312.

That we have not been able to find any other case directly in point than People *vs.* Clark is not strange; because usually no case reaches a superior court except as it comes from an inferior court; and under such circumstances, it is usually the jurisdiction of the lower court which is inquired into, or, if not, the superior court passes *directly* upon its own jurisdiction.

And we submit that, upon principle, there can be no objection to the Supreme Court of the District in the case at bar passing upon the jurisdiction of the Court of Appeals. As already shown, it has been repeatedly held that an United States court, either of the same or of a different State, may inquire into the jurisdiction of a State court, or a State court into the jurisdiction of a court of another State. In these cases no opportunity is given to the court whose jurisdiction is inquired into to vindicate that jurisdiction; while, in the case at bar, even had the Supreme Court of the District upon the petition for mandamus determined that the Court of Appeals had no jurisdiction on the "appeal," the Court of Appeals, upon an appeal, would have had the final "say" (as it did, except for the writ of error now before the Supreme Court) as to its own jurisdiction.

The foregoing arguments are based upon the supposition that, had the question of the constitutionality of this "appeal" been raised by a motion to dismiss at the time of the "appeal," that question could have been carried to the Supreme Court. Still more ought the mandamus to be sustained, if it could not; for, if the question could not have been carried to the Supreme Court at that time, then it is clear that this mandamus afforded and affords the only chance to bring the question before the Supreme Court.

II.

A mandamus will not lie if there is another adequate remedy.

We fully recognize this principle. It means, however, if there is another adequate remedy at the time the petition for mandamus is filed. It does not mean, if there *was* a remedy at a *previous time.* And it is certain that the petition for man-

damus in the case at bar was not filed until after the "appeal" by Northall to the Court of Appeals had been determined.

As to whether we had any other adequate remedy at the time the petition for mandamus was filed, so that the mandamus will not lie, we refer to our brief in reply to that of Mr. Wilson, and also to Section V of the "Additional Points by the Solicitor General on Oral Argument," which is as follows:

"V.

"If any section is open to the objection that it does not provide sufficiently for carrying into effect the decision of the court, it is section 4915, which simply provides that 'such adjudication, if it be in favor of the right of the applicant, shall *authorize* the Commissioner to issue such patent on the applicant's filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law.*'

"My information from the Patent Office is that an adjudication under section 4915 is not recognized as being a final and conclusive determination that a patent shall and must issue to the successful applicant before the court. After a copy of the adjudication is filed in the Patent Office, there still remains in the Commissioner the discretion to pass upon the question whether the applicant has otherwise complied with the requirements of law."

III.

On the hearing, counsel for plaintiff in error stated, in answer to a question of Mr. Justice White, that, though a decision be rendered by the Court of Appeals of the District of Columbia in favor of a party to an interference and a patent be issued to such party in accordance with the decision of that Court, the question of priority of invention may nevertheless be raised and determined in a subsequent proceeding between the same parties; and (if the defendant is a citizen of the District) even in the Supreme Court of the District, though a court inferior to the Court of Appeals.

This is evident from Secs. 4914 and 4915 R. S., and from Cochrane *vs.* Deener, 94 U. S., 780, and The Mergenthaler Linotype Co. *vs.* Seymour, etc., 660 O. G., 1311.

"The statute is not ambiguous. It gives a court of equity power to decide between interfering patents, **with-**

out any exception or limitation." (Machine Co. *vs.* Crane, 1 Ban. & A., 494, Fed. Cas. No. 14,388; Wheaton *vs.* Kendall, 85 Fed. Rep., 671.)

More than this, questions which might have been raised but were not raised in the interference proceeding, may be raised in the proceeding in equity.

> "The failure of a party in an interference proceeding in the Patent Office to raise the question whether his opponent's invention includes the issue declared in the interference does not estop such party to raise that question in an equity suit under Rev. St., Sec. 4915, to determine his right to a patent." (Christy *vs.* Seybold, 55 Fed. Rep., 69.)

The latter case was an appeal from the Circuit Court of the United States for the District of Kentucky to the Circuit Court of Appeals for the Sixth Circuit. J. Taft, Circuit Court Judge, said:

> "The interference issue is drawn up by the Patent Office Examiner and the interference is declared before either party has access to the specifications of the other and the claims made with respect to the issue are submitted before the specifications are disclosed. Subsequently, perhaps, the question (whether an opponent's invention includes the issue declared in the interference) might be raised, but we do not think that failure to raise it in the Patent Office prevents its being brought to the attention of the court in a proceeding like this by independent bill."

> "In a suit between interfering patentees under Rev. St., Sec. 4918, the decision of the Patent Office in favor of one of the parties is not *res adjudicata* upon the question of priority of invention between them, and a bar to further litigation in the Circuit Court." (Hubel *vs.* Tucker *et al.*, 24 Fed. Rep., 701.)

IV.

In the preface to McArthur's Patent Cases, Vol. I, p. V, the author, in commenting on appeals from the decisions of the

Commissioner to the Supreme Court of the District of Columbia, sitting in general term, says:

> "In their anomalous relations with an executive department the judges do not exercise the purely judicial functions of a court of record. The judgment is recorded in the Patent Office and controls the further proceedings of the Commissioner, but does not preclude any person interested from renewing the contest in another forum."

All of which is respectfully submitted.

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